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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,438	03/29/2001	J. Guy Breitenbacher	ORT-1396	5665

27777 7590 11/18/2002  
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EXAMINER
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LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/820,438	Applicant(s) Breitenbucher et al.
Examiner Hong Liu	Art Unit 1624

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Oct 1, 2002
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 835 C.D. 11; 453 O.G. 213.
- 4)  Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) 23-32 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1, 2, 8-16, and 20-22 is/are rejected.
- 7)  Claim(s) 3-7 and 17-19 is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-32 are pending in this application.

This action is in response to the applicants' amendment and reply filed on October 1, 2002.

#### *Election/Restriction*

Applicant's election of Group I is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The restriction requirement is therefore made FINAL.

#### *Response to Arguments*

Applicants' arguments filed on October 1, 2002 have been fully considered but they are not persuasive. Rejections to Claims under 35 U.S.C. 112, second paragraph, 102(b) and 103(a) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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***Claim Rejections - 35 USC § 112***

The rejection to claims 1-17, 20, and 21 under 35 U.S.C. 112, first paragraph, is hereby withdrawn. Applicants' argument has been noted and found persuasive.

The rejection to claims 1, 9, and 12-18 under 35 U.S.C. 112, second paragraph, is maintained for reasons already made of record. For the term of "amide" and "ester" there are only examples with a limited number of species in the specification. The definition of "heterocycle" does not specify the size of the ring and the term "heterocycle" in the claims are much broader than the limited examples given by the specification. Reading a claim in light of the specification is different from reading limitations of the specification into the claim. See *In re Prater*, 415 F.2nd 1393, 162 USPQ 541. These claims themselves do not carry the limitation as specified in the specification. When the claims having these phrases are given the broadest interpretation, it is still open-ended in terms of the nature and number of the substituents.

***Claim Rejections - 35 USC § 102***

The rejection to claims 1, 2, 8, 10-16, 20, and 21 under 35 U.S.C. 102(b) as being anticipated by Chirgadze et al. (WO 98/48797) is hereby withdrawn in view of the difference in the substituents on the phenyl and heterocycle attached to the nitrogen of the indole ring.

Claims 1, 2, 8, 10-16, 20, and 21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Neuenschwander et al. (5,385,912). Applicants' argument had been fully

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considered but not found persuasive. A bridged bicyclic core is within the definition of Z which is a heterocycle. *overcome by fourth defining 2*

Claims 1, 2, 8, 10-16, 20, and 21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Connor et al. (WO 98/06703). The example on page 24 shows that the functional group corresponding to Z is a piperidine. *overcome*

Claims 1, 8, 10, 12, and 26 remain rejected under 35 U.S.C. 102(b) as being anticipated by Agarwal et al. First, all the reference compounds have an indole core. Second, applicants argue that they do not claim a benzoyl. However, W' is defined as C(O), and Z' is defined as phenyl optionally substituted by halogen. *overcome by amending 2*

Claims 1, 2, 8, 10, 12-16, 20, and 21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Joshi et al., Chem Abstract 105: 190834. There are altogether 12 structures. Some of the indole are substituted with fluorine whereas others are not substituted. Therefore, applicants' amendment to substitute indole with chlorine does not overcome all the anticipated species.

#### ***Claim Rejections - 35 USC § 103***

The rejection to claims under 35 U.S.C. 103(a) as being unpatentable over Chirgadze et al. (WO 98/48797) is hereby withdrawn for the same reason given above.

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Claims 1, 2, 8-16, 20, and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Neuenschwander et al. (US 5,385,912) for the same reason given in the above 102 rejection.

Claims 1, 2, 8-16, 20, and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Connor (WO 98/06703). Applicants' arguments have been fully considered but they are not found persuasive. Applicants' attention is directed to the definition of R7 on pages 7-8. R7 can be NR10R11 wherein R10 and R11 can be combined to form a heterocyclic ring, which corresponds to Z. The nitrogen attached to the phenyl ring corresponds to W which can be N.

#### *Claim Objections*

Claims 3-7 and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record nor a search in the pertinent art area teaches the compounds where R<sup>3</sup> is as defined in Claims 3-7 and 17-19.

#### *Conclusion*

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl  
November 11, 2002

*Mukund S. Shah*  
Mukund Shah  
Supervisory Patent Examiner  
Art Unit 1624